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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/590,976 06/09/00 PEDERSON

J N47.2-9184

EXAMINER

TM02/0913

VIDAS ARRETT & STEINKRAUS PA  
SUITE 2000  
6109 BLUE CIRCLE DRIVE  
MINNETONKA MN 55343-9131

LIEU, J

ART UNIT

PAPER NUMBER

2632

DATE MAILED:

09/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/590,976

Applicant(s)

PEDERSON, JOHN C.

Examiner

Julie Lieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 0900.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 48-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office action is in response to the pre-amendment filed 6/9/00. Claims 1-47 have been canceled. New claims 48-79 have been added.

#### *Double Patenting*

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 48-79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 43 and 45-79 of copending Application No. 09/590,585. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of the claims in this application are the same as combination of claims 43 and 45-79 in application 09/590,585

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 48-51 and 76-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall (US Patent No. 5,585,783).

Claim 48:

Hall teaches:

- a. A light support 22 having a front side (fig. 1)
- b. A plurality of LEDs 16 arranged about and extending from the front side of the light support 22
- c. A controller U1 in communication with light sources for selectively activating the LEDs thereby producing more than two different types of visually distinct warning light signals (that is, continuous, flashing, or rotating)(see fig. 5), the LED receiving power from a power source wherein the light support .

Claim 49:

The light support in Hall comprises a back side having a second visible exterior surface having a plurality of LEDs arranged about and attached to the second visible exterior surface.

Claim 50:

The controller U1 controls the LEDs on the first visible exterior surface and a second visible exterior surface for the provision of different warning light signals on the first visible exterior surface and the second visible exterior surface.

Claim 51:

The controller U1 has a microprocessor.

Claim 76:

Hall teaches:

- a. A light support 22 having a front side (fig. 1)
- b. A plurality of LEDs 16 arranged about and attached to the visible exterior surface, the LEDs being angled relative to the light support such that the light output beam is horizontal
- c. A controller U1 in communication with light sources for selectively activating the LEDs thereby producing more than two different types of visually distinct warning light signals (that is, continuous, flashing, or rotating)(see fig. 5), the LED receiving power from a power source wherein the light support .

Claim 78:

In Hall, more than two different types of visually distinct warning light signals are produced independently of one another (rotating, flashing, or steady)

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 64-67 and 70-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (US Patent No. 5,585,783).

Claims 64 and 65:

Hall discloses:

- a. A light support 22 having a front side having a first visible exterior surface
- b. A plurality of LEDs 16 arranged about and extending from the front side of the light support 22
- c. A controller U1 in communication with light sources for selectively activating the LEDs thereby producing more than two different types of visually distinct

warning light signals (that is, continuous, flashing, or rotating)(see fig. 5), the LED receiving power from a power source wherein the light support.

The front side or back side of the light support in Hall is not planar. However, it would have been obvious to one skilled in the art to provide a planar-front light support in Hall because the reference itself suggests that the light support can be formed to any shape as desired.

Claim 66:

The controller U1 controls the LEDs on the first visible exterior surface and a second visible exterior surface for the provision of different warning light signals on the first visible exterior surface and the second visible exterior surface.

Claim 67:

The controller U1 has a microprocessor.

Claim 70-75:

The rejection of claims 70-71 recites what was discussed in claims 64-69.

7. Claims 52-61 and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schugt et al. (US 5,934,694) in view of Hall (US Patent No. 5,585,783) and further in view of Deese (US Patent No. 5,806,965).

Claims 52 and 53:

The Hall reference fails to disclose LEDs of different colors. However, Deese teaches the use of different colored LEDs and controlling the LEDs to create at least one of a single colored light signal and at least one of a multi-colored warning light signal. Col. 7, last paragraph. It would have been obvious to one skilled in the art to use colored LEDs and the

warning patterns taught in Deese in the combination of Hall and Schugt because it would provide a more effective warning signal.

Claim 54:

The light support 22 in Hall is flexible and constructed and arranged to form into a plurality of shapes. Figs. 6-8.

Claim 55:

The warning light signals in the combined system are selected from the group consisting of: a revolving light, an alternating light, an oscillating light, a flashing light, a stroboscopic light and any combination thereof.

Claim 56:

The plurality of LEDs in Hall is in the form of an array.

Claim 57:

The plurality of LEDs in Hall is illuminated sequentially by sequencer 38 to create the appearance of rotation.

Claim 58:

The plurality of LEDs in Hall and Deese are illuminated to create the appearance of multi-colored rotation.

Claim 59:

The controller in Hall selectively illuminating the LEDs to create a plurality of visually distinctive warning light signals.

Claim 60:



The warning signal in Hall is not a directional indicator. However, it would have been obvious to one skilled in the art that to use an directional indicator in the Hall signal light as desired because the Hall device is used as a marker device to direct passer-bys.

Claim 61:

Regarding the claimed external programmable controller, one skilled in the art to readily recognize that in order for the warning signal light to produce different warning patterns it must be programmed to do so and therefore it would have been obvious to one skilled in the art to use a programmable device to program the controller to produce different warning signals as desired.

Claims 68-69:

The Hall reference fails to disclose LEDs of different colors. However, Deese teaches the use of different colored LEDs and controlling the LEDs to create at least one of a single colored light signal and at least one of a multi-colored warning light signal. Col. 7, last paragraph. It would have been obvious to one skilled in the art to use colored LEDs and the warning patterns taught in Deese in the combination of Hall and Schugt because it would provide a more effective warning signal.

8. Claims 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (US Patent No. 5,585,783) in view of Schugt et al. (US Patent No. 5,934,694).

Claim 62:

Schugt et al. discloses a warning light for use with a motorized vehicle. Since the warning light in Hall is also used on a vehicle, it would have been obvious for one skilled in the

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art to use the warning light of Hall in Schugt because the Hall warning light has more visual effects than the light in Schugt.

Claim 63:

The signal light in Hall is not specifically used on an emergency vehicle though it is meant to be used on a vehicle and as emergency warning light. Therefore, it would have been obvious to one skilled in the art to use the warning light in Hall on an emergency vehicle as desired because it is well known that emergency vehicles use warning light which produces signaling effect as that in Hall's.

***Allowable Subject Matter***

9. Claims 77 and 79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 703-308-6738. The examiner can normally be reached on Mon-Thurs, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 703-305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6743 for regular communications and 703-308-6743 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read 'Julie Lieu', with a long horizontal flourish extending to the right.

Julie Lieu  
Primary Examiner  
Art Unit 2632

Jl  
September 7, 2001